

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK B. SUPINSKI AND HENRY QUAN

Appeal No. 2001-1719
Application No. 09/069,907

ON BRIEF

Before CALVERT, COHEN and FRANKFORT, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 17, 19 and 22, all the claims remaining in the application.

The claims on appeal are drawn to a bracket for mounting an expansion card in a computer chassis (claims 1 to 14 and 22), and a method for manufacturing a bracket (claims 15 to 17 and 19).

The references applied in the final rejection are:

Kurz

4,987,517 Jan. 22, 1991

Petitpierre 5,491,613 Feb. 13, 1996

The appealed claims stand finally rejected as follows:

- (1) Claims 1 to 4, 12 to 16, 19 and 22, anticipated by Kurz, under 35 U.S.C. § 102(b).
- (2) Claims 5 to 11 and 17, unpatentable over Kurz in view of Petitpierre, under 35 U.S.C. § 103(a).

Rejection (1)

Claim 1 reads:

1. A bracket for mounting a expansion card in a computer chassis, the bracket comprising:

a primary surface having a rear face and a front face, the primary surface extending between a top end and a bottom end, the front face adapted to be aligned against a first surface of the computer chassis; and

a first appendage extending outward from the rear face of the primary surface and adapted to couple to a recessed portion of the expansion card, the first appendage having a proximal end at the rear face of the primary surface and a distal end opposite the proximal end, the distal end adapted for coupling the first appendage to the recessed portion of the expansion card.

In considering the language of this claim, we note that the recitation in lines 6 and 7 that the first appendage is “adapted to couple to a recessed portion of the expansion card” is unclear if the expression “a recessed portion of the expansion card” is given its ordinary and accustomed meaning. This expression would normally be considered to refer to a cut-out area of the card, e.g., to recessed area 26 shown in appellants’ Fig. 2, and it would not be evident how the appendage could couple to a cut-out area, i.e., to an empty space. However, construing this claim in light of the appellants’ specification, In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), we interpret the expression “a recessed portion of the expansion card” in claim 1 (and the similar expression in lines 9 and 10 of claim 15) to mean the portion of the expansion card which lies on the opposite side of the recessed portion from the primary surface (claim 1) or major surface (claim 15) of the bracket. This is consistent with appellants’ disclosure as shown in Fig. 3 and described at, for example, page 7, lines 2 to 8.

Kurz discloses a bracket for mounting an expansion card, there being a first appendage 60 extending outward from the rear face of primary surface 52 of the bracket and coupled to expansion card 10 at its distal end 62. Kurz does not disclose or show that the card 10 has a recessed portion, but the examiner takes the position,

however, that Kurz anticipates claim 1, et seq., notwithstanding the recitations in claim 1 that the first appendage is “adapted to couple to a recessed portion of the expansion card” and has a “distal end adapted for coupling the first appendage to the recessed portion of the expansion card.” As explained on pages 5 and 6 of the examiner’s answer:

the appellant fails to positively claim the expansion card, but does claim the distal end of the first appendage being adapted for coupling the first appendage to the recessed portion of the expansion card. See claim 1. The expansion card is nominally recited. Therefore, Kurz must provide for the ability of coupling the first appendage to another component. Please note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

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appellant fails to positively recite the recessed portion of an expansion card which appellant repeatedly relies on for patentability.

We do not consider this rejection to be well taken. While we agree with the examiner that the “adapted to” recitations in claim 1 do not cause the expansion card to be included as part of the claimed combination, see In re Dean, 291, F.2d 947, 130 USPQ 107, 111 (CCPA 1961), we do not agree that there is no structural difference between the subject matter of claim 1 and Kurz, or that Kurz is capable of performing

the intended use. The “adapted to” recitations are limitations of claim 1, In re Dean, supra, and cannot be ignored. The bracket disclosed by Kurz does not meet these limitations because there is no indication therein that appendage 60 is so positioned and sized as to be capable of coupling to a recessed portion of an expansion card (as we have construed this expression, supra). Absent any express or inherent disclosure of these limitations, Kurz does not anticipate claim 1, nor it follows, claims 2 to 4, 12 to 14 and 22, dependent thereon.

As for method claim 15, the examiner states on page 7 of the answer that:

Finally, Appellant states Kurz does not teach a method for manufacturing a bracket. Since the structural [sic] is critical to the steps being performed, the method claims are predicated on the structural recitation for patentability. The structure is clearly set forth in the Kurz and Petitpierre reference, accordingly.

It is not clear what is meant by this statement, but in any event, we find no disclosure in Kurz of any method of manufacturing the bracket disclosed therein, let alone of any steps corresponding to the forming and manipulating steps recited in claim 15. Kurz therefore does not anticipate claim 15, or dependent claims 16 and 17.

Accordingly, rejection (1) will not be sustained.

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Rejection (2)

We will not sustain this rejection, since Petitpierre does not supply the above-discussed deficiencies of Kurz.

Conclusion

The examiner's decision to reject claims 1 to 17, 19 and 22 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
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